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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/679,569	10/06/2003	Carlos E. Collazo	OSTEONICS 3.0-456	3144
530	7590	08/11/2005	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			REIMERS, ANNETTE R	
			ART UNIT	PAPER NUMBER
			3732	

DATE MAILED: 08/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/679,569	<b>Applicant(s)</b> COLLAZO, CARLOS E.	
	<b>Examiner</b> Annette R. Reimers	<b>Art Unit</b> 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 1-11, 17 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-16, 18 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-16, 18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ceniz (U.S. Patent Number 3,981,604).

Ceniz discloses a cylindrical bushing, e.g. figure 2, comprising a cylindrical body with an outer bearing surface, e.g. 21 of figures 2 and 3, for rotatably engaging a surface of the fixture in which the bushing is mounted, the outer bearing surface extending circumferentially around an outer cylindrical surface of the bushing, a longitudinal bore formed in the body (see figure 2) and a plurality of recesses extending radially outward from the bushing central bore, e.g. 22 of figure 2. In addition, the cylindrical outer bearing surface extends about an axis, which is coaxial with an axis of the longitudinal bore (see figures 2 and 3).

Each recess is capable of receiving at least two flutes (see figures 2, 4, and 5). Furthermore, the recesses are capable of extending a distance greater than a largest radial extent of the flutes of the at least two reamers, since the Cenis bushing device can accommodate any reamer design having straight flutes (see figures 2, 4 and 5). Moreover, the bushing is capable of having a number of recesses equal to or greater than the number of flutes of each of the reamers (see figures 2, 4, and 5). In addition, the recesses and the flutes expand in width on moving radially outward from the bushing body longitudinal bore or the inner shaft, respectively (see figure 4).

Claims 12-14, 18 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ball et al. (U.S. Patent Publication 2003/0163151).

Ball et al. disclose a cylindrical bushing, e.g. figure 4, comprising a cylindrical body with an outer bearing surface, e.g. 23 of figure 4, for rotatably engaging a surface of the fixture in which the bushing is mounted, the outer bearing surface extending circumferentially around an outer cylindrical surface of the bushing, a longitudinal bore formed in the body (see figure 4) and a plurality of recesses extending radially outward from the bushing central bore, (see figure 4). In addition, the cylindrical outer bearing surface extends about an axis, which is coaxial with an axis of the longitudinal bore (see figures 4 and 5).

Each recess is capable of receiving at least two flutes (see figure 4). Furthermore, the recesses are capable of extending a distance greater than a largest radial extent of the flutes of the at least two reamers, since the Ball bushing device can accommodate any reamer design having straight flutes (see figure 4). Moreover, the

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bushing is capable of having a number of recesses equal to or greater than the number of flutes of each of the reamers (see figure 4).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ceniz (U.S. Patent Number 3,981,604).

Ceniz discloses the claimed invention except for where the plurality of recesses have radial ends opposite ends thereof open to the bore at a shorter radial distance from the axis of the longitudinal bore than the outer cylindrical surface of the bushing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Ceniz where the plurality of recesses have radial ends opposite ends thereof open to the bore at a shorter radial distance from the axis of the longitudinal bore than the outer cylindrical surface of the bushing, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

***Response to Arguments***

Applicant's arguments filed on May 23, 2005 have been fully considered, but they are not persuasive. In response to Applicant's arguments that the Ceniz and the Ball et al. references show non-rotating elements and lack a cylindrical body with an outer bearing surface. The cylindrical body of the Ceniz and Ball et al. references has an outer bearing surface (see Figures 2-3 of Ceniz and Figures 4-5 of Ball et al.) that is capable of rotatably engaging a surface of the fixture in which the bushing is mounted, e.g. manually rotatably engaging the outer bearing surface of the cylindrical body with a surface of the fixture. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

In response to Applicant's argument that the Ceniz device is directed to a machine tool not used in orthopedics, the fact that Applicant uses a bushing for a different purpose does not alter the conclusion that its use in a prior art device would be prima facie obvious from the purpose disclosed in the reference. In addition, it is noted that the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. Kalman v. Kimberly Clark Corp., 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed

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structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987). Moreover, the bushing device of Ceniz is capable of being a bushing for a bone reamer (see argument above).

In response to Applicant's argument regarding the obviousness rejection of claims 23 and 24, the limitation on which the Applicant relies (i.e., "a slotted bushing where the slots have edges for scraping the accumulated corrosion of off pins and other tools inserted therein or to reduce friction between the liner bushing and the slip renewable bushing) is not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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EDUARDO C. ROBERT  
PRIMARY EXAMINER